

U.S. Application Serial No: 10/622,299
Amendment dated March 30, 2006
In response to Office Action dated November 30, 2005

REMARKS

Claims 1 to 20 are in this application.

Claims 2 to 4 and 15 to 20 have been cancelled.

Claims 21 to 31 have been added.

Claims 1, 5 to 7 and 14 have been amended.

Claims 1, 5 to 14, and 21 to 31 are currently pending in this application.

A request for a one-month extension of time is hereby made to extend the period for response to March 30, 2006.

Claim 1 has been amended to incorporate the contents of claims 2 to 4 into claim 1. Claim 1, as amended, reads:

1. A composition for topical application to the skin comprising:

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a pearlescent component having a bismuth oxychloride-containing pearlescent ingredient wherein said pearlescent component is matched to a natural skin tone benchmark shade;
a pigment component that is separately shade-matched to said benchmark shade; and
a cosmetic carrier;
wherein said pearlescent component and said pigment component form a blend present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition.

Claim 14 has been amended to incorporate the contents of claims 15 to 19 into claim 14. Claim 14, as amended, reads:

"14. A method for preparing a cosmetic composition for topical application to the skin comprising:
shade-matching a pearlescent component having a bismuth oxychloride-containing pearlescent ingredient to a natural skin tone benchmark shade to form a shade-matched pearlescent component;
shade-matching a pigment component to the benchmark shade to form a shade-matched pigment component;
blending said shade-matched pearlescent component and said shade-matched pigment component to form a shade-matched blend; and
adding said shade-matched blend to a cosmetic carrier to form a cosmetic composition;
wherein said shade-matched blend is present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition."

In view of the cancellation of claims 2-4, the dependence of

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claims 5 to 7 has been changed accordingly.

Applicants have added new claim 31 to define:

31. The composition of claim 1, further comprising a colored pigment which is bonded to said bismuth oxychloride in said pearlescent component.

Support for a composition of claim 1 further comprising a colored pigment which is bonded to the bismuth oxychloride is found on page 13, lines 4 to 14, which states:

"Preferably, the pearlescent component has a bismuth oxychloride based pearlescent ingredient or reflectance pearls. Bismuth oxychloride matches the skin's natural pearlescence more than compounds such as titanium oxide, which provide for a more artificial look. Bismuth oxychloride better mimics the skin's natural reflectance. However, other pearlescent ingredients may be used. A preferred pearlescent component is called CHROMA-LITE, which is a combination of colored pigment bonded to BI-LITE 20 (bismuth oxychloride and mica) using calcium stearate. The CHROMA-LITE component is available in various shades/color from Englehard Corporation (Iselin, New Jersey)."

Accordingly, new claim 31 is allowable.

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Similarly, new claim 30, which recites that the composition in the method of claim 14 further comprises a colored pigment which is bonded to the bismuth oxychloride in the pearlescent component and, as such, claim 30 is also allowable.

Claims 14 to 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite with respect to "shade-matching a pearlescent component to a natural skin tone benchmark shade to form a shade-matched pearlescent component."

Applicants have amended claim 14 to recite the steps of the claimed method. Thus, what is claimed is:

"14. A method for preparing a cosmetic composition for topical application to the skin comprising:
 shade-matching a pearlescent component having a bismuth oxychloride-containing pearlescent ingredient to a natural skin tone benchmark shade to form a shade-matched pearlescent component;
 shade-matching a pigment component to the benchmark shade to form a shade-matched pigment component;
 blending said shade-matched pearlescent component and said shade-matched pigment component to form a shade-matched blend; and
 adding said shade-matched blend to a cosmetic carrier to form a cosmetic composition;

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wherein said shade-matched blend is present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition."

Claims 14 to 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite with respect to "shade-matching a pearlescent component to a natural skin tone benchmark shade to form a shade-matched pearlescent component."

Claims 15 to 20 have been canceled. Therefore, their rejection is moot.

On page 12, line 4 to page 13, line 14, Applicants describe the shade-matching the pearlescent component to a natural skin tone benchmark shade as follows:

"Shade matching of color cosmetic composition using pigments is known to those of ordinary skill in art of color cosmetics. In known shade matching, a shade of color (such as a skin color) is selected as a "benchmark" and ingredients (usually the pigment component) are added and/or adjusted to match the shade of the "benchmark". What the present invention has discovered is that when this known art of pigment shade-matching is also used to shade-match a separate pearlescent component to skin color, the resultant colored cosmetic mimics healthy skin's natural glow more accurately than any heretofore commercial colored cosmetic

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product. This is especially true for any known foundation cosmetics products.

A significant feature of the present invention is that the pearlescent component is matched to the desired natural skin tone (hereinafter "benchmark shade") rather than simply added as an accent to a shade-matched pigment component, as has been done in the prior art. The shade-matched pearlescent component may include any color-based pearls or any combinations thereof. The pearlescent component can be matched to the desired natural skin tone benchmark shade according to any known shade-matching method known in the art or by using the method noted above.

Preferably, the pearlescent component has a bismuth oxychloride based pearlescent ingredient or reflectance pearls. Bismuth oxychloride matches the skin's natural pearlescence more than compounds such as titanium oxide, which provide for a more artificial look. Bismuth oxychloride better mimics the skin's natural reflectance. However, other pearlescent ingredients may be used. A preferred pearlescent component is called CHROMA-LITE, which is a combination of colored pigment bonded to BI-LITE 20 (bismuth oxychloride and mica) using calcium stearate. The CHROMA-LITE component is available in various shades/color from Englehard Corporation (Iselin, New Jersey)."

Thus, shade-matching a pearlescent component to a natural skin tone benchmark shade to form a shade-matched pearlescent component is clearly described and is not at all indefinite.

Accordingly, the rejection of claim 14 under 35 U.S.C. 112, second paragraph, as being indefinite should be withdrawn and

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claims 14, and claims depending directly or indirectly therefrom,
should be allowed.

Claim 20 has been rejected under 35 U.S.C. 112, second
paragraph, as being indefinite with respect to "desired skin
color."

Claim 20 has been canceled. Accordingly, the rejection of
claim 20 under 35 U.S.C. 112, second paragraph, as being
indefinite is moot.

Claims 1, 3 to 14, and 16 to 20 have been rejected under 35
U.S.C. 112, first paragraph, as being enabling for bismuth
oxychloride, but not for "any pearlescent component in general
that is matched to a natural skin tone bench mark shade."

The rejection of claims 3, 4, and 16 to 20 under 35 U.S.C.
112, first paragraph, is moot since claims 3, 4, and 16 to 20
have been cancelled.

Applicants have amended claims 1 and 14 to define:

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"a pearlescent component having a bismuth oxychloride-containing pearlescent ingredient wherein said pearlescent component is matched to a natural skin tone benchmark shade."

Thus, claims 1, 3 to 14, and 16 to 20 are enabling for bismuth oxychloride-containing pearlescent ingredients.

Claims 1 to 12, and 14 to 20 have been rejected under 35 U.S.C. 102(b) as being anticipated by Brieva et al. (U.S. Patent No. 5,800,816).

The rejection of the canceled claims 2 to 4 and 15-20 is moot.

Brieva et al. does not teach or suggest the composition of claim 1 or the method of claim 14.

Thus, Brieva et al. does not teach or suggest the composition of claim 1 in which:

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(1) the pearlescent component is matched to a natural skin tone benchmark shade;

(2) the pigment component is separately shade-matched to the benchmark shade;

(3) the pearlescent component and the pigment component form a blend;

(4) the blend is present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition;

(5) the balance being a cosmetic carrier.

Further, Brieva et al. does not teach or suggest the steps of method of claim 14, which defines method for preparing a cosmetic composition for topical application to the skin. Brieva et al. does not teach or suggest the steps of:

(1) shade-matching a pearlescent component;

(2) shade-matching a pigment component to the benchmark shade in a separate step;

(3) blending the shade-matched pearlescent component and the shade-matched pigment component to form a shade-matched blend; and

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(4) adding the shade-matched blend to a cosmetic carrier to form a cosmetic composition;

(5) the shade-matched blend being present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition.

Thus, Brieva et al. does not teach or suggest the method of claim 14 or the composition employed in the method of claim 14.

Accordingly, the rejection of claims 1, 5 to 12, and 14 under 35 U.S.C. 102(b) as being anticipated by Brieva et al. should be withdrawn and claims 1, 5 to 12, and 14, and claims depending directly or indirectly therefrom, including the newly presented claims, should be allowed.

Claims 1 to 10, and 13 to 20 have been rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al. (U.S. Patent No. 6,511,672).

The rejection of the canceled claims 2 to 4 and 15-20 is moot. Accordingly, the under 35 U.S.C. 102(e) rejection applies

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to claims 1, 5 to 10, 13 and 14, claims 1 and 14 being independent claims.

Tan et al. does not teach or suggest the composition of claim 1 or the method of claim 14.

Thus, Tan et al. does not teach or suggest the composition of claim 1 in which:

(1) the pearlescent component is matched to a natural skin tone benchmark shade;

(2) the pigment component is separately shade-matched to the benchmark shade;

(3) the pearlescent component and the pigment component form a shade-matched blend;

(4) the shade-matched blend is present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition;

(5) the balance being a cosmetic carrier.

Further, Tan et al. does not teach or suggest the steps of

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method of claim 14, which defines method for preparing a cosmetic composition for topical application to the skin. Tan et al. does not teach or suggest the steps of:

- (1) shade-matching a pearlescent component;
- (2) shade-matching a pigment component to the benchmark shade **in a separate step**;
- (3). blending the shade-matched pearlescent component and the shade-matched pigment component to form a shade-matched blend; and
- (4) adding the shade-matched blend to a cosmetic carrier to form a cosmetic composition;
- (5) the shade-matched blend being present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition.

Thus, Tan et al. does not teach or suggest the method of claim 14 or the composition employed in the method of claim 14.

Accordingly, the rejection of claims 1, 5 to 10, 13 and 14 under 35 U.S.C. 102(e) as being anticipated by Tan et al. should

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be withdrawn and claims 1, 5 to 10, 13 and 14, and claims depending directly or indirectly therefrom, including the newly presented claims, should be allowed.

Claims 1 to 9, and 14 to 20 have been rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al. (U.S. Patent No. 6,372,202).

The rejection of the canceled claims 2 to 4 and 15-20 is moot. Accordingly, the rejection by Simon et al. under 35 U.S.C. 102(e) applies to claims 1, 5 to 9, and 14, claims 1 and 14 being independent claims.

Simon et al. does not teach or suggest the composition of claim 1 or the method of claim 14.

Thus, Simon et al. does not teach or suggest the composition of claim 1 in which:

(1) the pearlescent component is matched to a natural skin tone benchmark shade;

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(2) the pigment component is separately shade-matched to the benchmark shade;

(3) the pearlescent component and the pigment component form a shade-matched blend;

(4) the shade-matched blend is present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition;

(5) the balance being a cosmetic carrier.

Further, Simon et al. does not teach or suggest the steps of method of claim 14, which defines method for preparing a cosmetic composition for topical application to the skin. Simon et al. does not teach or suggest the steps of:

(1) shade-matching a pearlescent component;

(2) shade-matching a pigment component to the benchmark shade in a separate step;

(3) blending the shade-matched pearlescent component and the shade-matched pigment component to form a shade-matched blend; and

(4) adding the shade-matched blend to a cosmetic carrier to

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form a cosmetic composition;

(5) the shade-matched blend being present in an amount of about 0.01 wt% to about 50 wt% based on the total weight of the composition.

Thus, Simon et al. does not teach or suggest the method of claim 14 or the composition employed in the method of claim 14.

Accordingly, the rejection of claims 1, 5 to 9, and 14 under 35 U.S.C. 102(e) as being anticipated by Simon et al. should be withdrawn and claims 1, 5 to 9 and 14, and claims depending directly or indirectly therefrom, including the newly presented claims, should be allowed.

Regarding the newly presented claims 30 and 31, none of the cited references teach or suggest a method or composition which further includes a colored pigment which is bonded to the bismuth oxychloride in the pearlescent component.

Accordingly, claims 30 and 31 are also allowable.

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A request is made herewith for a one-month extension of time to extend the period for response to March 30, 2006.

In view of the foregoing, Applicants respectfully request reconsideration of the currently pending claims and allowance of claims 1, 5 to 14, and 21 to 31.

Accordingly, the issuance of a Notice of Allowability is earnestly solicited.

Respectfully submitted,

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